

REMARKS

Reconsideration of the application is requested.

Claims 1-8 and 10-19 remain in the application. Claims 1-8 and 10-19 are subject to examination. Claims 1, 11, 12 and 16 have been amended. Claim 9 has been canceled to facilitate prosecution of the instant application.

Under the heading "Claim Rejections - 35 USC § 102" on page 2 of the above-identified final Office Action, claims 1, 2, 11 and 12 have been rejected as being fully anticipated by U.S. Patent No. 5,983,112 to Kay (hereinafter Kay) under 35 U.S.C. § 102.

Claims 1 and 11 have been amended to overcome the rejection with the feature of "detuning, with at least one capacitor, an oscillating circuit of a carrier frequency generator". Kay is believed to be silent in regard to this feature. Support for the addition of this feature is found from page 14, line 26 to page 15, line 14 of the specification of the instant application. Claim 12 as originally recited also claims this feature in its second paragraph and as noted by the Examiner in item 6 of the Office Action Kay does not teach a frequency generator that generates a plurality of different carrier frequencies. In addition, support for the recitation of an

"access code" is found on page 2, lines 1-15 of the specification.

In item 4 on page 3 of the above-identified final Office Action, claims 3-9 have been rejected as being obvious over Kay in view of U.S. Patent No. 6,314,125 to Shanbhag (hereinafter Shanbhag) under 35 U.S.C. § 103.

Claims 3-9 ultimately depend on amended claim 1 and therefore are also believed to be allowable.

In item 5 on page 3 of the above-identified final Office Action, claims 9-10 have been rejected as being obvious over Kay under 35 U.S.C. § 103.

Claims 9-10 ultimately depend on amended claim 1 and therefore are also believed to be allowable.

In item 6 on pages 4 and 5 of the above-identified final Office Action, claims 12-19 have been rejected as being obvious over Kay in view of U.S. Patent No. 5,036,294 to McCaslin (hereinafter McCaslin) under 35 U.S.C. § 103.

The Examiner relies on McCaslin to teach a crystal oscillator and at least one capacitor as a way of producing different

carrier frequencies. McCaslin discloses a phase-locked control loop where frequency jitter is to be compensated. A switched capacitor network that reduces the amplitudes of the frequency jitter for low frequencies is used for this purpose. A comparison of the output signals with the reference clock signals takes place continuously in the phase detector 12. As soon as the output signal changes in its phase due to frequency jitter, the size of the frequency jitter is changed by connecting or switching off capacitors in the capacitor network. In order to reduce the frequency jitter, a constant/continuous adaptation or control thus takes place.

In addition, McCaslin is not believe to teach outputting or generating different carrier frequencies useful for transmitting the data messages. McCaslin is believed to be concerned with teaching a single, jitter free carrier signal and not providing multiple frequencies for data transmission.

In contrast, the invention of the instant the application teaches that a complete signal that contains the complete access code, is transmitted and the carrier frequency is changed thereafter timewise in order to once again transmit the access code in a signal at a different carrier frequency. The changes of the carrier frequencies thus take place step-by-step and only within a transmission channel (commonly:

permitted transmission channel/frequency band in a narrow frequency region, for example at 433.05-434.79 MHz). A continuous change of the frequency is not necessary nor desired.

It can thus also not be seen how McCaslin is supposed to contribute towards getting to the object of the application in combination with Kay. Kay pertains to a mobile telephone system. A person of skill in the art would not have any reason at all to combine the two prior art references. As the only commonality, McCaslin discloses the possibility of compensating for frequency jitter with the help of capacitors. The frequency of the output oscillator is thereby constantly regulated and not in jumps (purposeful frequency changes) after transmission of a complete signal, as it is the case in the object of the application.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be

understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125,1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50

USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the examiner is requested to withdraw the rejection.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1, 11, 12, and 16. Claims 1, 11, 12 and 16 are, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 1, 12 or 16.

In view of the foregoing, reconsideration and allowance of claims 1-8 and 10-19 are solicited.

In the event the Examiner should still find any of the remaining claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out. In the alternative, the entry of the amendment is requested, as it is believed to place the application in better condition for appeal, without requiring extension of the field of search.

Petition for extension is herewith made. The extension fee for response within a period of one month pursuant to Section 1.136(a) in the amount of \$110.00 in accordance with Section 1.17 is enclosed herewith.

Appl. No. 09/994,197
Amdt. Dated August 13, 2004
Reply to Office Action of April 13, 2004

If an extension of time is required, petition for extension is herewith made. Any extension fee associated therewith should be charged to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Please charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,



For Applicants

REL:cgm

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